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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,949

03/19/2004

Xinming Wang

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1762

MAIL DATE

DELIVERY MODE

04/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/803,949

Applicant(s)

WANG ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,6-19 and 31-34.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**


8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: (1) the proposed amendment to the specification at paragraph [0093] raises the issue of new matter. The Examiner noted the confusion as to the definitions of the terms applicant is attempting to define at paragraph 6 of the Final Rejection of 11/20/06. Applicant has made no showing that the newly inserted terms are "alternate common names" of the previously confusing terms. (2) the proposed amendment to claim 1, last paragraph, "the pretreatment liquid is an aqueous liquid free of any oxidizing agent" raises new issues that would require further consideration and/or search by the Examiner as such a requirement has not previously been made. It also raises the issue of new matter, because there does not appear to be support in the disclosure as originally filed for such a negative limitation. (3) the proposed amendment to claim 1, last paragraph, to use the terms palladium hydrochloride, palladium sulfate, and palladium acetate, raises new issues that would require further consideration and/or search by the Examiner and raises the issue of new matter as requiring such materials was not previously made for the reasons as discussed in section (1) above as to the proposed amendment to the specification. (4) Moreover, the proposed amendment to claim 1, last paragraph to insert materials required by claim 31 raises new issues that would require further consideration and/or search by the Examiner, because the features of claim 31 were not previously required by the other dependent claims and would change the scope of these claims. (5) the proposed amendment to claim 32 to use palladium sulfate rather than "palladium sulfuric acid" would raise new issues that would require further consideration and/or search by the Examiner as there has been no showing that this means the same as was previously required by the claims, .

Continuation of 11. does NOT place the application in condition for allowance because: (1) as to the 35 USC 112 rejection of claims 31-32 this has been maintained for the reasons given in the Final Rejection of 11/20/06, as the proposed amendment has not been entered as discussed in Box 3 above. (2) as to the 35 USC 103 rejections of the claims, this has been maintained for the reasons given in the Final Rejection of 11/20/06, as the proposed amendment has not been entered as discussed in Box 3 above, and all of applicant's arguments are addressed to the claims as proposed to be amended, including no oxidizing agent in the pretreatment liquid, which was not a requirement of the claims as worded in the amendment of 10/6/06...

  
KATHERINE BAREFORD  
PRIMARY EXAMINER